



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,830	04/12/2001	Roberto Morlesin	Q63809	1936

7590

05/20/2003

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213

EXAMINER

LEON, EDWIN A

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,830

Applicant(s)

MORLESIN, ROBERTO

Examiner

Edwin A. León

Art Unit

2833

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003 and 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-12,17-21,23 and 24 is/are rejected.
- 7) ☒ Claim(s) 3-7,13-16 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and Request for Continued Examination filed April 29, 2003 in which Claim 1 has been amended and new Claims 23-24 have been added, have been placed of record in the file as Papers No. 10 and 13, respectively.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 8-9, 12, 17-21 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Crededio et al. (U.S. Patent No. 5,435,740). With regard to Claims 1, 9, 17-18, 21 and 23-24, Crededio et al. discloses a interconnection comprising a conductive core (15,17,18) including a metal conductor (15) with, at each end thereof, an electrical connector (17,18), and a flexible tube (10) having at least an insulating layer (45) made of elastomeric material and covering the whole conductive core (15,17,18) and passing a medium voltage (Column 4, Lines 22-26) through the interconnection. The method limitations are deemed inherent. See Figs. 1-3A.

Art Unit: 2833

The recitation "a medium voltage" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

The limitation "for realizing an electrical connection between a receiving connector of a first equipment station and a receiving connector of a second equipment station" has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

The limitations "adapted to electrically connect a receiving connector of a first equipment station and a receiving connector of a second equipment station", and "adapted to mate the receiving connector" have not been given patentable weight since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

With regard to Claims 2, 12 and 19-20, Crededio et al. discloses the electrical connector (17,18) having a substantially conical shape of which a base (7) is connected to the metal conductor (15), the base (27) having a diameter relatively larger than the diameter of the metal conductor (15). See Figs. 1-3A.

Art Unit: 2833

With regard to Claim 8, Crededio et al. discloses the flexible tube (45) having the same length as the conductive core (15,17,18). See Figs. 1-3A.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crededio et al. (U.S. Patent No. 5,435,740). Crededio et al. discloses the claimed invention except for the elastomeric material being a synthetic terpolymer of ethylene, propylene and diene [EPDM] or silicone.

Thus, it would have been obvious to one with ordinary skill in the art at the time the invention was made to use a synthetic terpolymer of ethylene, propylene and diene [EPDM] or silicone, since it has been held to be within the general ordinary skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Allowable Subject Matter

6. Claims 3-7, 13-16 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references fail to teach, disclose, or suggest, either alone or in combination, a conical bushing means made of insulating material and provided with the receiving connector so as to bring the electrical connector of the conductive core into contact with the receiving connector and the insulating layer of the flexible tube into contact with the inner side of the bushing means, the flexible tube having coaxially starting from the center: a first semiconductive layer, an insulating layer made of elastomeric material, and a second semiconductive layer, a ring groove in the first semiconductive layer, and a ring groove partially in the insulating layer, an external locking ring on at least one electrical connector of the conductive core, and at least one internal ring groove in the flexible tube for receiving the locking ring of the electrical connector when the tube is released over the conductive core, and the flexible tube expanding and the conductive core including the first electrical connector relatively sliding inside the flexible tube.

Art Unit: 2833

Response to Arguments

7. Applicant's arguments with respect to claims 1-2, 8-12, 17-21 and 23-24 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. León whose telephone number is (703) 308-6253. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Edwin A. Leon
AU 2833
EAL
May 8, 2003


Gary Paumen
Primary Examiner